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This paper is responsive to an Office Action mailed December 26, 2006. Prior to this response, claims 1-19 were pending. After amending claims 1-2, 7, 9-11, 16, and 19, and canceling claims 5-6 and 14-15, claims 1-4, 7-13, and 16-19 remain pending.

In Section 3 of the Office Action claims 1-4, 9-13, and 18-19 have been rejected under 35 U.S.C. 102(e) as being anticipated by Hutchinson (US 2003/0145218). With respect to claims 1, 9, 10, and 19, the Office Action states that Hutchinson discloses all the elements of the claimed invention.

Claims 1, 9, 10, 19 have been amended to include the subject matter of claims 6 and 15, which was not found to be anticipated. Claims 2-3, dependent from claim 1, and claims 11-13 and 18, dependent from claim 10 enjoy the same advantages over the cited prior art, and the Applicant requests that the rejection be removed.

In Section 6 of the Office Action claims 5, 7-8, 14, and 16-17 have been rejected under 35 U.S.C. 103(a) as being unpatentable with respect Hutchinson. The Office Action acknowledges that Hutchinson does not expressly describe hashing a password, but discloses a PGP encryption. The Office Action states that it would have been obvious to replace the encrypted password with a hashed password, with the motivation being that Hutchinson teaches discusses data compression to reduce the amount of data to be encrypted.

As noted above in response to the anticipated rejection, claims 1 and 10 have been amended to include the subject matter of claims 6 and 15, respectively. Since the examiner has rejected claims 6 and 15 by combining

two references, the Applicant respectfully submits that obviousness rejection of claims 5, 7-8, 14, and 16-17, based solely on the Hutchinson reference is now moot, as these dependent depend from amended independent claims. Therefore, the Applicant requests that the rejection be withdrawn, and reconsidered in light of both the Hutchinson and McGraw references, as discussed below.

In Section 7 of the Office Action claims 6 and 15 have been rejected under 35 U.S.C. 103(a) as being unpatentable with respect Hutchinson, in view of McGraw (US 6,542,261). The Office Action acknowledges that Hutchinson does not expressly describe transmitting a file including an unencrypted header with an identification of the scanned document. The Office Action states that McGraw transmits an encrypted document with a hashed password and an unencrypted header identifying the document. The Office Action states that it would have been obvious to incorporate McGraw's unencrypted header into Hutchinson's system, with the motivation being that "a hotel's business center would need to know which guest the secure FAX should be delivered to". This rejection is traversed as follows.

An invention is unpatentable if the differences between it and the prior art would have been obvious at the time of the invention. As stated in MPEP § 2143, there are three requirements to establish a *prima facie* case of obviousness.

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior

art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck* 947 F.2d 488, 20 USPQ2d, 1438 (Fed. Cir. 1991).

Hutchinson generally describes a printer that is able to use PGP encryption to store electronic copies of a document. At paragraphs 0014 and 0029, the Office Action states that Hutchinson alludes to the transmission of an encrypted document with a password from a source to a network-connected printer, with the quote that "...it is conceivable that the present invention can be embodied in a combination of separate devices..." However, a careful reading of the paragraph shows that Hutchinson is using this quote to describe only printing and scanning functions. Paragraph 0014 is as follows:

[0014] FIG. 1 is a simplified elevational view of a digital copier and an associated computer, showing the essential elements thereof relevant to the present invention. *Although the Figure shows the scanning and printing functions* (emphasis added) of a digital copier 10 within a single "box," it is conceivable that the present invention can be embodied in a combination of separate devices, such as a standalone scanner, general-purpose computer, and network-controlled printer. One or more such copiers 10 can in turn be interconnected to any number of computers, and/or to each other, using known network protocols and systems; the invention could also be directed to a context including a facsimile machine. Original sheets, bearing images to be copied, are placed on an input tray 12, where they are automatically fed by generally known means such as a document handler including a constant-velocity transport (CVT) roll 14, and then placed in catch-tray 16. While each sheet is moved on CVT roll 14 through what can be called a scanner process direction P1, successive small areas on the sheet are illuminated and recorded by a linear photosensor array 18, which may be of any type known in the art such as a charge-coupled device (CCD) or CMOS device, along with appropriate optics (not shown), which converts the light reflected by the

small areas into digital data. The array 18 may also be used for exposure of images on sheets which are placed on a platen, in a manner familiar in the art.

The Applicant respectfully submits that the distribution of printing and scanning functions over multiple "boxes" cannot fairly be interpreted as evidence that Hutchinson suggests the transmission of encrypted documents with an accompanying password.

McGraw describes a system that transmits an encrypted fax document with an unencrypted heading, indicating the intended recipient (col. 3, ln. 1-30). The fax message, in either paper or electronic form, is converted into a graphics (scan) document. Typically, the encrypted fax paper document is scanned, and secure fax driver software decrypts the document (col. 4, ln. 9-31). In one aspect, a computer employees a custom "fax card" to streamline the process (col. 4, ln. 37-49).

The fax document can be encrypted using a number of well-known technologies (col. 4, ln. 30). However, McGraw does not transmit a password with the encrypted document. The user must select a code at the transmit side, but the code is not sent with the document (col. 6, ln. 17-34). The recipient must present a "decode code", but this code is not something that the user recovers from the received document (col. 6, ln. 38-62).

With respect to claims 1, 9, 10, and 19, the Hutchinson and McGraw references have been combined based upon the assumption that combination of references discloses all the elements of the claimed invention. The Applicant's independent claims have been amended to recite that a file is transmitted (or received) with a header and an encrypted document. The header includes an unencrypted identification of the document and a hashed password. As noted above, neither Hutchinson nor McGraw discloses the transmission of a password. More explicitly, neither reference discloses the

transmission of a password with an encrypted document. However, the claimed invention recites even narrower limitations than these. The claimed invention recites the transmission of a hashed password which is included in the header along with an unencrypted identification of the encrypted document. Once again, neither Hutchinson nor McGraw discloses the transmission of a hashed password in a file header, as recited in claims 1, 9, 10, and 19. Claims 2-4, and 7-8, dependent from claim 1, and claims 11-13 and 16-18, dependent from claim 10, also enjoy the same distinctions from the cited prior art.

With respect to the first *prima facie* requirement, the Office Action states that it would have been obvious to incorporate McGraw's unencrypted header into Hutchinson's system, with the motivation being that "a hotel's business center would need to know which guest the secure FAX should be delivered to". However, even if this statement were correct, it does not explain how an expert in the art could have modified the Hutchinson reference in such a way as to describe the claimed invention. As explained above in response to the third *prima facie* requirement, even when combined, Hutchinson and McGraw fail to disclose all of the claimed invention limitations. The above-quoted statement from Office Action does not explain how even a person with skill in the art could modify Hutchinson's encrypted/decrypted printer memory system, in light of a fax system that leaves the recipient's name unencrypted for delivery purposes, to yield the limitations of the claimed invention. Alternately stated, the motivation to combine these references cannot be built upon a mere desire to aid hotel delivery. Rather, to meet the first *prima facie* requirement, there must be an explicit teaching in the McGraw reference that shows an expert how the Hutchinson reference can be modified to yield the claimed invention. Such a

prima facie case has not been made, simply because all the Applicant's claim limitations cannot be found in the two references.

Alternately, if the Examiner is relying upon the knowledge of a person with skill in the art to supply motivation lacking the Hutchinson/McGraw references, then additional evidence must be provided. Notable, when the source or motivation is not from the prior art references, "the evidence" of motive will likely consist of an explanation or a well-known principle or problem-solving strategy to be applied". *DyStar*, 464 F.3d at 1366, 80 USPQ2d at 1649. The Examiner has not supplied any explanation of how an expert could possibly modify either Hutchinson or McGraw to yield all the explicit limitations recited in the base claims.

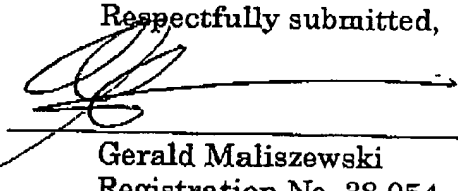
Considered from the perspective of the second *prima facie* requirement, even if an expert were given the Hutchinson and McGraw inventions as a foundation, no evidence has been provided to show that there is a reasonable expectation of success in the claimed invention.

In summary, the Applicant respectfully submits that a *prima facie* case of obvious has not been supported, and the Applicant requests that the rejection of claims 1-4, 7-13, and 16-19 be removed.

It is believed that the application is in condition for allowance
and reconsideration is earnestly solicited.

Respectfully submitted,

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